

REMARKS

Responsive to the Notice of Non-Compliant Amendment mailed December 3, 2008, Applicants submit herewith a new listing of the claims in this application. This amendment is intended to correct any alleged errors in the claim listing supplied in the Response to Notice of Non-Compliant Amendment ("the Response") filed November 14, 2008. Applicants note that a Request for Continued Examination was filed in connection with the above-referenced application on December 8, 2008. Pursuant to MPEP 714, the corrected claim listing and arguments presented in the above-referenced Response are supplied herewith.

Claims 1-24 are pending and are rejected. Claim 29 is allowed. Claims 1, 11, 24 and 30 are amended, and claim 31 is added. Claims 2, 3, and 25-28 and 17 are cancelled. Upon entry of the present amendment, claims 1, 4-16, 18-24, 29, 30 and 31 are pending.

Support for the Amendment

Support for the amendments is found in the specification and claims as originally filed. For example, support for the amendment of claims 1, 11, and 24, which now recite a β -glucuronidase enzyme, collagen, and arthritis, is found at page 4, third paragraph, and at page 10, second and third paragraphs. No new matter is added.

Restriction Requirement

The Examiner requires withdrawal of claim 30 based on the assertion that claim 30 is directed to an invention that is independent of the invention presently claimed. Applicant respectfully disagrees and traverses. Applicant notes that these remarks are also relevant to new claim 31, which is directed to the use of the composition of claim 29.

The present restriction requirement is improper because it requires restriction between a composition and a method of using that composition.

Furthermore, where restriction was required between a product and a process of making and/or using the product, and the product invention was elected and subsequently found allowable, all claims to a non-elected process invention must depend from or otherwise require all the limitations of an allowable claim for the

claims directed to that process invention to be eligible for rejoinder (emphasis present in original). M.P.E.P. § 821.04

The Examiner required restriction between Group I, claims 1-24 and 29, which are directed to therapeutic compositions, and Group II, claims 25-28, which are directed to methods of treating an autoimmune disease. The Examiner acknowledged that claims to such processes would be eligible for rejoinder at page 5, first full paragraph, of the Restriction Requirement mailed August 3, 2007. Specifically, the Examiner stated:

Where applicant elects claims directed to the product, and the product claims are subsequently found allowable, withdrawn process claims that depend from or otherwise require all the limitations of the allowable product claim will be considered for rejoinder.

Claims 30 and 31 depend from and recite the use of the composition of claims 1 and 29, respectively. The Examiner has indicated that claim 29 is allowable, and Applicant expects that claim 1, as presently amended, is also in condition for allowance. Accordingly, rejoinder and examination of claims 30 and 31 with the invention of Group I is respectfully requested.

Rejections under 35 U.S.C. § 112, first paragraph

The Examiner rejects claims 1-24 under 35 U.S.C. § 112, first paragraph, as lacking enablement. In support of the enablement rejection, the Examiner alleges that Applicant's specification fails to enable the treatment of any autoimmune disorder with a combination of any enzyme and any immunogen. Applicant respectfully disagrees and traverses the rejection.

However, without acquiescing in any way to the rejection and in order to expedite prosecution of the application, claims 1 and 11, from which rejected claims 4-24 depend, have been amended, and claims 2 and 3 have been cancelled without prejudice or disclaimer, thereby obviating the rejection. Claims 1 and 11 are now directed to therapeutic compositions for the treatment or prophylaxis of arthritis, the compositions comprising a β -glucuronidase enzyme and collagen. The Examiner acknowledges that Applicant has enabled the treatment of arthritis, as described at page 10, second and third paragraphs, where Applicants describe the use of β -glucuronidase and collagen for the treatment of arthritis. Moreover, the Examiner acknowledges

that Applicant's discovery that this composition could treat arthritis is surprising with respect to the prior art.

Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection.


CONCLUSION

Applicants believe all formalities have been complied with and a complete response has been submitted. It is respectfully submitted that this application is now in condition for allowance with claims 1, 3-24, 29, 30 and 31. Should any issues remain or should the Examiner believe that a telephone conference with Applicants' attorney would be helpful in expediting prosecution of this application, the Examiner is invited to contact the undersigned at the telephone number shown below.

Applicants believe that no fee is due to consider the present amendment. Nevertheless, the Director is hereby authorized to charge or credit any deficiency in the fees filed, asserted to be filed or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105.

Dated: January 5, 2009

Respectfully submitted,

By 

Melissa Hunter-Ensor, Ph.D., Esq.

Registration No.: 55,289

EDWARDS ANGELL PALMER & DODGE
LLP

P.O. Box 55874

Boston, Massachusetts 02205

(617) 517-5580

Attorneys/Agents For Applicant